

## REMARKS

The present application, United States Serial No. 10/525,189, was filed on November 7, 2005. Claims 23 and 41 have been amended and claim 40 has been canceled by the present RCE Submission. In view of amendments and remarks set forth herein, Applicants respectfully request reconsideration of the application and the issuance of a formal Notice of Allowance directed to claims 23-39 and 41.

### Claim Amendments

Claim 23 has been amended to incorporate the subject matter of claim 40, and claim 40 has been canceled. Claim 41 has been amended to change the dependency from claim 40 to claim 23.

### 35 U.S.C. § 103

Claims 23-33, 37 and 39-41 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over EP 0 147 483 to Delany, et al. ("Delany") in view of U.S. Patent Application Publication No. 2001/0038872 A1 to Brooker ("Brooker") for reasons stated in the Office Action mailed December 9, 2008. Applicants respectfully traverse such rejection. It is respectfully submitted that the rejection of claim 40 is hereby rendered moot as such claim has been canceled herein. Accordingly, no further remarks are presented pertaining to this claim.

Preliminarily, Applicants note that, on page 2 of the Office Action mailed December 9, 2008, the Office has alleged that "Delany teaches of a method of making ice cream comprising homogenizing a mix of ingredients, aging the mix to precrySTALLize particles of edible fat . . ." (emphasis added). Applicants respectfully submit that Delany does not teach the use of precrySTALLisation of fat particles to manufacture ice cream, as that term is defined in the present application. As used throughout the present application, precrySTALLisation refers to the process of crystallising fat prior to incorporating the fat into a dispersion which will become a food product. See page 2, lines 13-24 of the present application. By direct contrast, Delany merely teaches crystallizing fat by homogenising and ageing after the fat has been combined with the other frozen food product ingredients.

Delany nowhere uses the term “precrySTALLISE”. Instead, Delany specifically teaches that crystallisation occurs during ageing of the mix of frozen food product ingredients, which is standard in traditional ice cream making processes. Thus, a person of ordinary skill in the art would understand that the term “precrySTALLISE” means that the fat is crystallised prior to combining with the other ingredients to create an emulsion in the ice cream manufacturing process. The crystallisation in Delany cannot, therefore, be understood to mean “precrySTALLISATION”.

As discussed in Applicants’ previous Response, Delany teaches a traditional ice cream making process, employing the usual process steps of forming an oil-in-water emulsion of ice cream ingredients and subjecting the emulsion to the typical homogenisation, pasteurisation, ageing and hardening steps. Delany also discloses the criticality of these traditional steps and the near impossibility of altering the traditional process. For example, Delany, at page 7, lines 15-19, discloses that “[i]t has quite unexpectedly been found that the selection and processing steps [of homogenization and aging] of the fat component during the preparation of the aforementioned aerated frozen food products are critical elements in achieving the unique stability of this invention” (emphasis added). Delany, at page 1, lines 29-34, further discloses that “rigid consumer acceptance criteria, regulatory standards and the complex nature of the interactions which produce a satisfactory product make it extremely difficult to reformulate such aerated frozen products in an attempt to provide improvements.”

Despite the criticality of the steps of fat selection, homogenisation and ageing to achieving the unique stability provided to frozen food products by the invention of Delany, the Office alleges that these steps can be “alleviated” by combination with Brooker. It is alleged, at page 6 of the Office Action mailed December 9, 2008, that “Brooker teaches that precrySTALLIZED particles can be formed in minimal time that do not require aging and that are of minimal size; thus by using the precrySTALLIZED fat particles as taught by Brooker, the need for aging is alleviated and to remove such a step would reduce the cost of production by reducing production time, as taught by Brooker.” Because of the criticality disclosed by Delany of the steps of selection, homogenisation and ageing, the unique stability of the products of Delany may be sacrificed if the critical steps are circumvented.

For the above reasons, Applicants respectfully submit that Delany and Brooker are not properly combinable because they each teach away from any combination with the other. MPEP § 2145(X)(D)(2) states that “[i]t is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)”. MPEP at 2100-168. Because Delany discloses a criticality of the steps of selection, homogenisation and ageing, and combining Delany with Brooker would render homogenisation and ageing obsolete, potentially resulting in an frozen food product lacking in the unique stability demanded by Delany, Delany teaches away from any combination with Brooker, and vice versa.

For the same reason, Applicants respectfully submit that combining Delany and Brooker would render the method and resulting food products of Delany unsatisfactory for their intended purposes. MPEP § 2143.01(V) states that, “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)”. MPEP at 2100-140.

Beginning at page 3 of the final Office Action, the Office responds to Applicants arguments in their previous response. The first of these reasons (emphasis added) is that “[i]t must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).”

As discussed above, Delany does not teach or suggest utilizing a precrystallised fat, because it teaches the criticality of the steps of selecting a fat, and homogenising and ageing the fat under certain conditions based upon the particular fat selected. Brooker does not disclose that the precrystallised fat disclosed therein can be utilized in frozen food products or ice creams. Because of the criticality of the steps disclosed in Delany, one of skill in the art would have had no expectation of success in modifying Delany with Brooker as alleged by the Office. Therefore, the only teaching or suggestion of the potential success of using a precrystallised fat

in a frozen food product or ice cream is gleaned only from the present application. Therefore, the Office has utilized improper hindsight reasoning in rejecting the present claims as unpatentable over any combination of Delany and Brooker.

For the same reasons, there is no teaching, suggestion, or motivation in either reference to combine Delany and Brooker as alleged by the Office. As discussed above, the Office has neglected to consider the criticality of the steps of selection, homogenisation and ageing in providing the uniquely stable frozen food product of Delany. Because these steps are critical to forming the uniquely stable product of Delany, there is no motivation in Delany to eliminate the steps, regardless of the disclosure of Brooker.

At page 5 of the final Office Action, the Office has alleged that “[i]t would be common sense to one of ordinary skill in the art if a processing step could be removed and substantially the same or an improved product could be formed to remove the step would [sic] save money on processing time and equipment.” However, there is no teaching or suggestion in either Delany or Brooker that combining the references would provide “substantially the same or an improved product”, because, according to the disclosure of Delany, it is unlikely that the uniquely stable product of Delany will be produced without performing the critical steps disclosed by Delany. The only teaching or suggestion that using a precrystallised fat in making a frozen food product such as ice cream would be desirable or successful is in the present application. Applicants respectfully submit that the Office has again used improper hindsight reasoning.

At page 6 of the final Office Action, the Office has alleged that, “to switch the order of performing process steps, i.e. the order of addition of the ingredients into the final mixture, would be obvious absent any clear and convincing evidence and/or arguments to the contrary”. Applicants respectfully submit that the above arguments clearly show that the order of the method steps of Delany is critical to achieving the stability disclosed by Delany. Moreover, the present application does not seek to switch the order of process steps, but rather it is directed to an improved method that does not include certain steps of Delany.

For the above reasons, Applicants respectfully request that the rejection of claims 23-33, 37 and 39-41 be withdrawn.

Claims 34-36 and 38 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Delany in view of Brooker, further in view of U.S. Patent No. 4,012,533 to Jonas ("Jonas") for reasons stated in the Office Action mailed December 9, 2008.

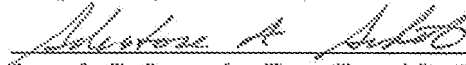
For all of the above reasons, in addition to those submitted in Applicants' previous Response, the Office's combination of Delany and Brooker is improper. Namely, Delany teaches away from using precrystallised fat particles to form an emulsion of ice cream ingredients, the Office utilized improper hindsight reasoning in combining the references, and there is no teaching, suggestion or motivation to combine the references. The use of a particular emulsifier based upon the disclosure of the Jonas reference does not render the combination of Delany and Brooker proper. Applicants therefore respectfully request that the rejection of claims 34-36 and 38 be withdrawn.

Applicants have addressed the instant rejections with respect to the independent claim(s) in particular, and have distinguished the applied references as discussed above. It is therefore deemed unnecessary to address specific allegations of the Office Action regarding the dependent claims. Applicants therefore traverse these allegations, and do not concur with the same either explicitly or implicitly by not refuting each individually.

## CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request withdrawal of the 35 U.S.C. § 103 rejections, and issuance of a Notice of Allowability with respect to claims 23-39 and 41. Should the Examiner have any questions about the present submission, the undersigned attorney would welcome a telephone call.

Respectfully submitted,



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